

REMARKS

Claims 1, 3-32 and 34-40, and 42 are pending in this application. By this Amendment, claims 1, 34, 37 and 42 are amended and claims 2 and 41 are canceled without prejudice to or disclaimer of the subject matter recited therein. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution by incorporation of the feature of dependent claims 2 and 41 into the independent claims and the incorporation of the "configured for" feature of independent claim 1 into similar independent claims 34 and 42; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. Pending Claims 1, 3-32 and 34-42 Define Patentable Subject Matter

The Office Action rejects claims 1-6, 10-18, 20, 23, 25-27, 30, 34 and 37-42 under 35 U.S.C. §102(b) over German Patent No. DE 296 14 364 to Stange. This rejection is respectfully traversed.

Independent claims 1 and 34 recite, *inter alia*, an applicator comprising "a base portion . . . configured for fixing onto a receptacle" and "a handle portion rotatably mounted on the base portion to turn about a fixed axis of rotation, the handle portion having a longitudinal axis, wherein the axis of rotation and the longitudinal axis of the handle portion are never mutually perpendicular and wherein the axis of rotation and the longitudinal axis are not parallel." Independent claim 42 is similar.

As previously argued, Stange's base is not "configured for" fixing onto a receptacle. Instead, Stange is directed to a standalone brush with a base that is not intended to be fixed and cannot be fixed without some additional, undisclosed structure. This distinction is summarily dismissed by the Patent Office citing that the feature is "intended use" and that Stange could be fixed to a receptacle. However, when evaluating claims for obviousness (as well as anticipation), all of the limitations of the claims must be considered and given weight. MPEP §2143.03. *Ex parte* Grasselli, 23 USPQ 393 (Bd. App. 1983) *aff'd* mem. 738 F.2d 453 (Fed. Cir. 1984). In this case, the recited "configured for" language is a positive recitation of structure that must be given patentable weight. For example, Applicant's Fig. 4 and paragraph [0012] show a screw thread as a suitable corresponding structure that configures the base portion for fixing onto the receptacle. Dependent claim 9 defines more specific structure, as well as dependent claim 35, which adds the receptacle removably mountable to the base.

Applicant respectfully requests that this claim language in independent claims 1, 34, and 42 be fully considered and given patentable weight.

With respect to method claim 37, the Office Action fails to make a prima facie case of anticipation because it fails to identify a teaching of the method step of modifying a direction of the base between two different application modes. Instead, Stange provides a brush that is mobile relative to the handle so as to enable drying of the brush without soap or water remaining trapped within the bristles. Thus, Stange suggests only a single application mode (i.e., conventional use in the vertical position for application of shaving cream), and a different angled position for the sole purpose of drying. This latter position is necessitated by the vertical positioning of the brush above the handle to achieve drying. This latter position is not taught to be useful for applying shaving cream and thus cannot be considered an application mode.

Therefore, because each and every feature of the independent claims are not found in Stange, Applicant respectfully submits that independent claims 1, 34, 37 and 42 and claims dependent therefrom are patentable over Stange. Accordingly, withdrawal of the rejection over Stange is respectfully requested.

The Office Action also rejects claims 1-5, 7-18, 20, 23, 25-27, 30-32, and 34-42 under 35 U.S.C. §103(a) over U.S. Patent No. 6,237,609 to Vasas in view of Stange. This rejection is respectfully traversed.

Vasas discloses a mascara brush and has no teaching or motivation to configure the stem or cap to render the stem or cap mobile in relation to the remainder of the device. Vasas also has no appreciation of advantages achieved from use of two different application modes for the brush.

As discussed above, Stange is not "configured for" fixing onto a receptacle and is instead a stand alone brush designed to merely be placed on a flat surface with the brush exposed for drying. Stange also is not concerned with advantages achieved by having two application modes which allow, for example, the brush to apply mascara to the left or right eye with the same hand movement (Applicant's paragraph [0010]) or to change the angle of attack for a different application effect (Applicant's paragraph [0009]). Instead, a shaving brush as in Stange just needs to generally apply shaving cream over a face in a non-exact manner. Thus, with respect to independent method claim 37, Stange like Vasas fails to teach two application modes.

One of ordinary skill in the art also would not have been motivated to combine Stange and Vagas. Stange discloses a brush having a tuft of bristles that is mobile relative to the handle so as to enable drying of the device without water or soap remaining trapped within the bristles. Such a problem is not faced by Vasas as its brush extends downward into a receptacle. Moreover, like Vagas, only a single application mode is disclosed in Stange.

Neither appreciates advantages of two different application modes to achieve different styling effects or to apply mascara to the left or right eye with the same hand movement. Thus, the rotatable base of Stange would have no utility in Vasas. Accordingly, independent claims 1, 34, 37 and 42 and claims dependent therefrom patentably distinguish over Vasas and Stange. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claims 7-9, 31, 32, and 35 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 3,97028 to Shay. This rejection is respectfully traversed.

Shay fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claims 7-9, 31, 32, and 35 are allowable for their dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 19 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 5,815,875 to Yamada. This rejection is respectfully traversed.

Yamada fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 19 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 21 under 35 U.S.C. §103(a) over Stange. This rejection is respectfully traversed.

Stange is discussed above and fails to teach each and every feature of independent claim 1. Accordingly, claim 21 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 22 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 4,922,575 to Riemann. This rejection is respectfully traversed.

Riemann fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 22 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 24 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 5,137,038 to Kingsford. This rejection is respectfully traversed.

Kingsford fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 24 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

The Office Action also rejects claim 29 under 35 U.S.C. §103(a) over Stange in view of U.S. Patent No. 3,164,856 to Samaras et al. (Samaras). This rejection is respectfully traversed.

Samaras fails to overcome the deficiencies of Stange with respect to independent claim 1. Accordingly, claim 29 is allowable for its dependence on allowable base claim 1 and for the additional features recited therein. Withdrawal of the rejection is respectfully requested.

II. Rejoinder of Withdrawn Claim 28 is Requested

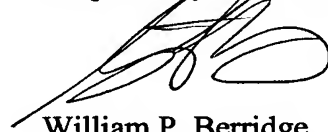
Claim 28 remains withdrawn from representation. However, rejoinder of claim 28 is respectfully requested in view of the allowability of claim 1 from which it depends.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-32 and 34-40 and 42 are thus earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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